



(10)

No. 1045

In the Supreme Court of the United States

OCTOBER TERM, 1945

COMPANHIA ANTONIO DE PAULISTA, PETITIONER

CONTRA F. DE COMMISSIONER OF REVENUE

ON PETITION FOR A WRIT OF HABEAS CORPUS TO REMOVE
STATES COURT OF APPEALS CASE NO. 1045 TO
COURT OF

RECEIVED FOR THE DEPARTMENT OF JUSTICE

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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 1045

COMPANHIA ANTARCTICA PAULISTA, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court of the United States for the District of Columbia (R. 5-6) is not officially reported. The opinion of the Court of Appeals for the District of Columbia (R. 14) is reported in 146 F. 2d 669.

JURISDICTION

The judgment of the Court of Appeals was entered on January 15, 1945 (R. 15). The petition for a writ of certiorari was filed on March 16, 1945. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the mark "Antaretica", as applied to beverages, syrups, and extracts, is entitled to registration under the Trade-Mark Act of February 20, 1905, Section 5 of which prohibits the registration of a mark which is "merely a geographical name or term."

STATUTE INVOLVED

Section 5 of the Trade-Mark Act of February 20, 1905, 33 Stat. 725, as amended, 15 U. S. C. 85, provides, in part:

No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

* * * *

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, * * *: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: * * *

STATEMENT

On July 7, 1941, petitioner, a company "existing under the laws of Brazil" and having its principal place of business there, filed its application with the United States Patent Office to register the mark "Antarctica", under the Trade-Mark Act of February 20, 1905, as a trade-mark for natural mineral waters, nonalcoholic maltless beverages, and syrups and extracts for making soft drinks (R. 2-3.) The mark had previously been registered by the petitioner in Brazil (R. 3). The Examiner of Trade-Marks refused to register the mark "'Antarctica' on the ground that the term is merely geographical" (R. 8-9) within the meaning of the proviso of Section 5 of the Act of February 20, 1905, and this decision was affirmed on appeal by the First Assistant Commissioner of Patents (R. 9-11).

Under Section 4915 of the Revised Statutes (35 U. S. C. 63), petitioner thereupon brought suit against the Commissioner of Patents in the United States District Court for the District of Columbia, to compel the Commissioner to allow the mark "Antarctica" registration under the 1905 Act (R. 2-4). That court dismissed the petitioner's complaint (R. 5-7). On appeal, the United States Court of Appeals for the District of Columbia affirmed the dismissal of the complaint, *per curiam*, rejecting petitioner's argument that the use of "Antarctica" as applied to its

product was fanciful and not "merely geographical" within the terms of the proviso of Section 5 of the Trade-Mark Act of 1905 (R. 14).

ARGUMENT

1. Section 5 of the Trade-Mark Act of 1905, under which petitioner sought registration of the word "Antarctica", provides that no mark shall be registered which consists in "merely a geographical name or term." Conceding that "'Antarctica' is a geographical name,"¹ petitioner argues that the mark is "purely fanciful" (Br. 15), and not "merely * * * geographical" and thus without the proviso of Section 5. But the court below refused to "read such an exception into the plain language of the act" (R. 14).

The courts have consistently held that Section 5 of the Trade-Mark Act, forbidding the registration of "merely a geographical name or term," is "broad enough to prohibit the use of any word that has an exclusive geographical significance, or that would suggest any particular geographical location" including "use of a name that applies to a particular section of the globe." *In Re Crescent Typewriter Supply Co.*, 30 App. D. C. 324, 326-327 (the word "Orient" as applied to ink ribbons

¹ Webster's New International Dictionary (Unabridged, Second Edition, 1939) defines "Antarctica" as "Matters connected with the antarctic." "Antarctic" is defined as "Opposite to the north, or arctic, pole; relating to the south pole or to the region near it."

and carbon paper); see also *In Re Hopkins*, 29 App. D. C. 118 ("Oriental" as applied to a skin cream); *Kentucky D. & W. Co. v. Old Lexington C. D. Co.*, 31 App. D. C. 223 ("Old Lexington Club" as applied to whiskey); *Montevallo Mining Co. v. Little Gem Coal Co. et al.*, 57 App. D. C. 100 ("Montevallo" as applied to coal); *In Re Deutz & Ortenberg, Inc.*, 296 Fed. 1012 (App. D. C.) ("House of France" as applied to clothing); *Black Band Consol. Coal Co. v. Glenn Coal Co.*, 20 F. 2d 284 (App. D. C.) ("Black Band" as applied to coal); *In Re California Perfume Co.*, 56 F. 2d 885 (C. C. P. A.) ("Avon" as applied to toothbrushes); *In Re Canada Dry Ginger Ale, Inc.*, 86 F. 2d 830 (C. C. P. A.) ("Canada Dry" as applied to a beverage); *In Re Kraft-Phenix Cheese Corporation*, 120 F. 2d 391 (C. C. P. A.) ("Chantelle" as applied to cheese); *Kraft Cheese Co. v. Coe*, 146 F. 2d 313 (App. D. C.) petition for certiorari filed March 27, 1945, No. 1084 ("Old English" as applied to cheese).²

² *American Steel Foundries v. Robertson*, 269 U. S. 372, on which petitioner heavily relies (Pet. & Br. 4-5, 12), did not involve a geographical name. Nor does the decision in that case stand for the proposition that all marks, susceptible of appropriation at common law, are registrable under the 1905 Act. This Court specifically stated that the common law rules were assumed to be adopted to "the extent that the contrary does not appear from the statute" (269 U. S. at 381). Merely geographical names or terms are denied registration by the statute, and here the court below, the district court, and the Commissioner of Patents all found that the name "Antartica" was a merely geographical name or term.

2. In stating that the mark "Antarctica" "was arbitrarily selected to indicate to the public the manufacturer or producer of the goods" (Br. 15), petitioner may be contending that its mark is entitled to registration because it will acquire a "secondary meaning". But there is nothing in the record to show that petitioner's products have been marketed in this country under the mark "Antarctica". Even before the enactment of the Trade-Mark Act of 1905, it was well recognized that "a mere geographical name" does not acquire a secondary meaning "without attending facts which have caused the name to become significant of a particular manufacture and to identify the manufacture as the product of a particular person". *La République Française v. Saratoga Vichy Springs Co.*, 107 Fed. 459, 461 (C. C. A. 2); see also *Columbia Mill Co. v. Alcorn*, 150 U. S. 460; *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665.

Moreover, the words "arbitrary, fanciful, or secondary meaning" do not appear in the proviso of Section 5.³ Thus with but a single exception,⁴ the courts have consistently recognized that,

³ The only "merely * * * geographical" marks presumed to have secondary significance under the 1905 Act are those registrable under the ten-year provision of Section 5—i. e., those which were used exclusively and in good faith for ten years before the passage of the 1905 Act. See *Illinois Watch Case Co. v. Shulton*, 111 F. 2d 298, 299 (C. C. P. A.);

irrespective of any arbitrary, fanciful, or secondary meaning, a mark is nevertheless not registrable under the 1905 Act if, by its terms, it is "merely * * * geographical". *In re Hopkins*, *In re Crescent Typewriter Supply Co.*, *In re Canada Dry Ginger Ale*, *In re Kraft Phenix Corporation*, *Kraft Cheese Co. v. Coc*, all *supra*.

see also *Manitou Springs Mineral Water Co. v. Schueler*, 239 Fed. 593, 602 (C. C. A. 8); *Elgin Nat. Watch Co. v. Elgin Razor Corp.*, 25 F. Supp. 886, 887 (N. D. Ill.). Petitioner did not seek registration of the mark "Antarctica" under the ten-year provision.

⁴ In the case of *In re Plymouth Motor Corporation*, 46 F. 2d 211 (C. C. P. A.), a mark comprising a picture of a sailing vessel at sea, together with the words "Chrysler Plymouth" was held by the Court of Customs and Patent Appeals to have "a meaning other than one merely geographic" and to be registrable under the 1905 Act (p. 213). But the doctrine of the *Plymouth* case was specifically rejected and "considered as overruled" by the same court in *In re Canada Dry Ginger Ale*, 86 F. 2d 830, 833. Since the decision in the *Canada Dry* case in 1936, it has been the policy of the Patent Office to reject all trade marks involving geographical terms, irrespective of a "secondary meaning". The alleged confusion in earlier Patent Office rulings, to which petitioner alludes (Pet. 7-8), is no longer of any significance.

CONCLUSION

The ruling of the court below is in accord with the consistent judicial construction of the Trade-Mark Act of 1905. The petition for a writ of certiorari should, therefore, be denied.

Respectfully submitted.

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